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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,568	02/05/2002	J.C. Tai	330-244	1950

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EXAMINER	
SALVATORE, LYNDA	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/062,568	TAI ET AL.	
	Examiner	Art Unit	
	Lynda M Salvatore	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,13 and 14* is/are pending in the application.

4a) Of the above claim(s) *6-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and accompanying remarks filed 02/25/04 have been fully considered and entered. Claims 1 and 13 have been amended and claims 2 and 6-12 have been canceled as requested. Applicant's amendment to claim 13 is found sufficient to overcome the claim objection set forth in section 7 of the last Office Action. As such, this objection is hereby withdrawn. Applicant's amendment to claim 1 is found sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in sections 9 and 10 of the last Office Action. As such, this rejection is hereby withdrawn. Despite this advance in prosecution, Applicant's amendments are not found to patentably distinguishable over the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Election/Restrictions

2. Claims 6-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected process there being no allowable generic or linking claim. Election was made **without** traverse filed 02/25/04.

Response to Arguments

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1,3-4,13 and 14 stand rejected under 35 U.S.C. 102(b) or in the alternative, under 35 U.S.C. 103(a) as obvious over Dahringer et al., by US 6,235,663.

Applicant amended claim 1 to include the limitations of canceled claim 2. Claim 1 now recites the limitation of "wherein the oil contains, as a main component, an ester obtained from polyethylene glycol having a molecular weight of 400 to 800 and a fatty acid having 10 to 20 carbon atoms". Claim 1 also was amended to clarify that the adhering oil decreases in weight "after heat treatment". Applicant argues that the relied upon reference of Dahringer et al., does not teach the limitation of a polyethylene glycol having a molecular weight of 400 to 800 and a fatty acid having 10 to 20 carbon atoms, but is directed to amine oxide comprising compound represented by the formula $R_1R_2R_3NO$. Applicant also asserts that decrease ratio of the amount of adhering oil taught by Dahringer et al., is much lower than the claimed at least 60%. (Applicant's response, Page 7, equation). These arguments are not found persuasive. In response to Applicant's assertion that Dahringer et al., is directed to amine oxide comprising composition, it is the position of the Examiner that Applicant's claim language does not preclude the existence of an amine oxide and maintains that Dahringer et al., clearly teaches in example 1d (Column 8, 5-10) the use of the claimed composition. Recall, Dahringer et al., teaches coating the staple fibers with a solution based on phosphoric acid esters and fatty acid polyethylene glycol esters and ethers (Column 8, 1-9). Suitable fatty acids include those derived from stearyl, oleyl and lauryl (Column 3, 30-35).

With regard to the molecular weight limitation present in newly amended claim 1, the Examiner maintains that though Dahringer et al., does not explicitly state the molecular weight of the polyethylene glycol it is reasonable to presume that said property is inherent to the polyethylene glycol used by Dahringer et al. Support for said presumption is found in the use of like materials such as polyethylene glycol and the use of like processes such as the use of

polyethylene glycol for the purpose of forming non-woven filter materials which can be electrostatically charged (i.e., an electret non-woven material). In other words, since the prior art meets the Applicant's oil adhering chemical, structural and final product limitations with the application of fatty acid polyethylene glycol ester to staple fibers and subsequently heat treating to produce a non-woven filter material capable of receiving electrostatic charge, it is the position of the Examiner that the molecular weight of the polyethylene glycol employed in the prior art invention is not only inherent, but must also be consistent with the polyethylene glycol of the instantly claimed invention. The burden of proof is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the molecular weight limitation would obviously have been present once the prior art product is provided. *In re Best*, 195 USPQ 433

With regard to the decrease ratio of the amount of adhering oil, Applicant calculated a value of 11.3% using the values given in examples 1d, 1e, and the amount of adhering oil on mat C after heat treatment. The Examiner acknowledges that this calculation is correct, however, it is respectfully pointed out that said calculated value was based on the amount of adhering oil (.12 wt %, example 1d) on the finished fiber and that Dahringer et al., teaches that up to 1 wt % of adhering oil may be applied to the finished fiber (Column 3, 10-12). Since it is not known if the decrease ratio is constant, it is reasonable to presume that if a greater amount of adhering oil is applied to the finished fiber that the decrease ratio of the amount adhering oil would increase. Additionally, it also pointed out that Applicant's claim language actually recites, "*can be*" at least 60%. The limitation of "*can be*" is not a positive limitation in the sense that it is not certain whether Applicant is claiming a decrease ratio of at least 60% just that it "*can be*" at least 60%.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dahringer et al., by US 6,235,663 as applied to claim 4 above.

The above 102(b)/103(a) rejection is maintained from which said rejection is based and Applicant has not present any new arguments for which to consider.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 7, 2004
ls

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